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TO: Commissioner for Patents
**Attn: Examiner Mary Mosher**
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Alexandria, VA 22313-1450

FROM: Karen S. Canady
OUR REF.: G&C 30967.3-US-D1
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| Title of Document Transmitted: | **RESPONSE TO RESTRICTION REQUIREMENT** |
| Applicant: | David M. Koelle et al. |
| Serial No.: | 10/073,834 |
| Filed: | February 11, 2002 |
| Group Art Unit: | 1648 |
| Our Ref. No.: | G&C 30967.3-US-D1 |

Please charge all fees to Deposit Account No. 50-0494 of Gates & Cooper LLP.

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Name: Karen S. Canady
Reg. No.: 39,927

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G&C 30967.3-US-D1

Due Date: December 21, 2003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

| | | | |
|---|---|---|---|
| Applicant: | Mary Mosher | Examiner: | Mary Mosher |
| Serial No.: | 10/073,834 | Group Art Unit: | 1648 |
| Filed: | February 11, 2002 | Docket: | G&C 30967.3-US-D1 |
| Title: | IMMUNOLOGICAL HERPES SIMPLEX VIRUS ANTIGENS AND METHODS FOR USE THEREOF | | |

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

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By: _____
Name: Karen S. Canady

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

We are transmitting herewith the attached:

☒ Transmittal sheet, in duplicate, containing a Certificate of Mailing or Transmission under 37 CFR 1.8.
☒ Response to Restriction Requirement.

**Please consider this a PETITION FOR EXTENSION OF TIME for a sufficient number of months to enter these papers, if appropriate.**

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By: _____
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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By
Name: Karen S. Canady

## RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This communication is submitted in response to the Office Action dated November 21, 2003. Because the due date, December 21, 2003, fell on a Sunday, this communication is timely filed on the next business day, Monday, December 22, 2003.

## REMARKS

At pages 2-3 of the Office Action, the Examiner required restriction of the application to one of 10 allegedly distinct inventions:

Inventions 1-5: Claims 1-6, 11, 26, 27, 30, 31, 35-38, and 43-54 polypeptides and compositions, drawn to UL19, UL21, UL49, gE, VP16 respectively, classified in class 424, subclass 231.1.

Inventions 6-10: Claims 7-10, 12-17, 32-34, 39-42, and 43-50 polynucleotides and compositions, drawn to UL19, UL21; UL49, gE, VP16 respectively, classified in class 514, subclass 44.

Applicants elect Group 3, namely claims 1-6, 11, 26, 27, 30, 31, 35-38, and 43-54, drawn to UL49 polypeptides and compositions, with traverse.

35 U.S.C. §121 provides that "If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions." M.P.E.P. §802.01 deviates from the plain meaning of "independent and distinct" by interpreting "and" to mean "or". The Patent Office relies on the absence from the legislative history of anything contrary to this interpretation as support for their position that "and" means "or". Applicants respectfully note that this position is contrary to the rules of statutory construction. Restriction between two dependent inventions is not permissible under the plain meaning of 35 U.S.C. §121.

The Examiner does not assert that the inventions of the claim groups listed above are independent. Rather, the Examiner alleges that the inventions of the claim groups listed above are distinct because they involve materials with distinct structural and functional characteristics. Applicants assert that restriction is improper because they are linked by the common discovery of a novel immunologically significant HSV antigen. As noted in the specification at page 5, lines 16-18, the invention relates to antigens and/or their constituent epitopes confirmed to be recognized by T-cells derived from herpetic lesions. Applicants further urge the Examiner take into consideration that the subject matter of each of the claim groups is linked by this common inventive concept.

According to M.P.E.P. §803, there are two criteria for a proper restriction requirement. First, the two inventions must be independent and distinct. In addition, there must be a serious burden on the Examiner if restriction is not required. Even if the first criterion has been met in the present case, which it has not, the second criterion has not been met.

Applicants assert that a search into prior art with regard to the invention of the different groups is so related that separate significant search efforts should not be necessary. For example, a search finding that UL49 polypeptides are novel and nonobvious should provide the necessary information for examination of polynucleotides encoding UL49 polypeptides without requiring an

additional search effort. Accordingly, there is no serious burden on the Examiner to collectively examine the claim groups listed above. Therefore, restriction is not proper under M.P.E.P. §803.

Consequently, Applicants respectfully request the Examiner reconsider and withdraw the restriction requirement. It is also submitted that this application is now in good order for allowance and such allowance is respectfully solicited. Should the Examiner believe minor matters still remain that can be resolved in a telephone interview, the Examiner is urged to call Applicants' undersigned attorney.

Respectfully submitted,

GATES & COOPER LLP
Attorneys for Applicant(s)

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